

**REMARKS**

Claims 1-5 and 7 remain pending in the above identified application and stand ready for further action on the merits.

In the instant amendment, the limitations of original claim 6 are inserted into claim 1, and claim 6 is cancelled to prevent a redundancy with amended claim 1. No new matter is incorporated into the application by way of the instant amendment to the claims.

***Claim Language Interpretation***

At page 2 of the office action, paragraphs “1.” to “5.” The Examiner (Laura C. Hill) sets forth her interpretation of various terms occurring in the claims of the application. While not specifically addressing each of the Examiner’s statements, it is noted that the pending claims recite the invention that the applicants regard as their own invention, both the literal embodiments encompassed thereby and equivalent embodiments encompassed thereby, as would be recognized by one of ordinary skill in the art.

***Claim Rejections – 35 USC § 112, Second Paragraph***

Claim 4 has been rejected under the provisions of 35 USC § 112, second paragraph as being indefinite. The Examiner apparently has trouble understanding the exact meaning of the phrase “*the distance from a longitudinal end of the absorbent member to a longitudinal end of the diaper in one of the longitudinal end sections thereof, and that in the other longitudinal end section is substantially equal.*”

The above language in claim 4 is intended to mean that the longitudinal ends of the absorbent member are about substantially equal distances from the longitudinal ends of the diaper.

As stated in M.P.E.P. §§ 2173.01 and 2173.02 :

*A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.*

*The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.*

Accordingly, based on the above statement of intended meaning, as well as the fact that each of the instantly pending claims 1-5 and 7 particularly and distinctly sets forth an inventive embodiment that the Applicants regard as part of their invention, it follows that the instant rejection of pending claim 4 must be withdrawn.

***Claim Rejections – 35 USC § 102/103***

At paragraph “7.” of the office action (*see pages 4-5 of the office action*), the Examiner sets forth a rejection of claims 1-4 and 7 as being anticipated under 35 USC § 102(b) or rendered obvious under 35 USC S 103(a) by the disclosure of Alemany et al. US ‘423 (US 5,234,423).

Reconsideration and withdraw of the above rejection is respectfully requested based upon the amendment made herein to claim 1, wherein limitations previously recited in claim 6 are now recited in claim 1. Since claim 6 was not rejected in this rejection of the claims, it follows that claim 1, and remaining claims 2-5 and 7, which either directly or indirectly depend therefrom are not anticipated or rendered obvious by the cited Alemany et al. US ‘423 reference. Any contentions of the US PTO to the contrary must be reconsidered.

***Claim Rejections – 35 USC § 103***

At paragraph “8.” of the office action (*see pages 6-7 of the office action*), the Examiner rejects claims 5-6 as being rendered obvious under 35 USC S 103(a) by the disclosure of Alemany et al. US ‘423, further in view of Breitkopf US ‘008 (US 5,034,008). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

*Legal Standard for Determining Prima Facie Obviousness*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the

proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

*Distinctions Over the Cited Art*

In the references being relied upon by the US PTO, there is no idea of producing a diaper having the instantly claimed limitations relating to flexural stiffness and saturated absorption capacity that are found in pending claim 1 (*which limitations are repeated immediately below*).

*two portions on opposite sides of a centerline dividing the length of the diaper in equal halves have a saturated absorption capacity ratio of from 45/55 to 55/45,*

*the absorbent member has a flexural stiffness of from 3 to 25 gf/50 mm as measured on a specimen cut out of the area from the longitudinal end of the*

absorbent member in the section having the fastening tapes to 50 mm inward in accordance with JIS K7171,

The instant inventors have discovered that having such limitations/properties in a diaper has enabled the Inventors to provide a diaper that is capable of being put on the diaper wearer either from either the front or back of wearer, including in an upright position (*e.g.*, see *Figures 3 and 4 of the instant Application, which are set forth below*). Especially, in the upright position, such limitations/properties help in being able to achieve a diaper that hardly leaks and can easily be put on wearer, even when put on a diaper wearer from the front or back side of the wearer.

Fig.3

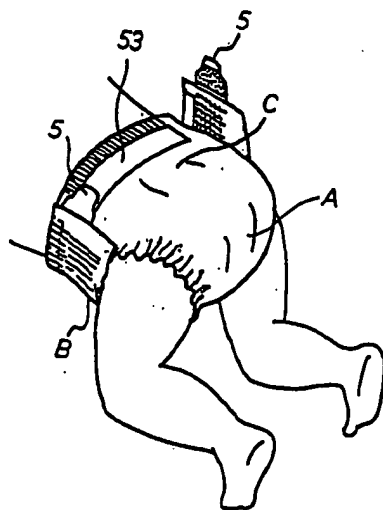
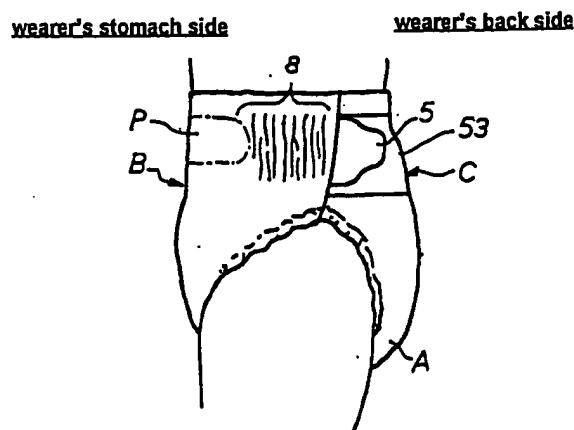


Fig.4



Regarding the absorption capacity of a general diaper, the absorption capacity of urine on the front side of a wearer is larger than that of the back side,

because urine is excreted from the front side of a wearer. As such, before the present invention, it was common in the art field of the instant invention for skilled persons in the art to make the saturated absorption capacity of the former side (i.e., front side) larger than that of the latter side (i.e., back side), *even if arguendo*, the area of the absorbent on the front side of a wearer were the same as that of the back side.

More particularly, it is submitted that no motivation is found in the art of record (e.g., Alemany et al. US '423 and/or Bretkopf US '008), or in the art field of the instant invention more generally, to provide for a diaper as instantly recited in claim 1, wherein "two portions on opposite sides of a centerline dividing the length of the diaper in equal halves have a saturated absorption capacity ratio of from 45/55 to 55/45". Any contentions of the US PTO to the contrary must be reconsidered.

It is additionally noted that the width of the longitudinal end section of the instant diaper is wider than the width of the absorbent member in the under-crotch section of a baby in the upright position. {For example, in claim 1, it is recited that "*a width of the absorbent member located between the pair of extensible side parts is equal to or greater than a minimum width of the absorbent member located in the crotch section of the diaper*".} Thus, in order to be easily put on a diaper wearer, it is important that in the inventive diaper flexural stiffness be relatively decreased. As such, instant claim 1 recites that "the absorbent member has a flexural stiffness of from 3 to 25 gf/50 mm as measured on a specimen cut out of the area from the longitudinal end of the absorbent

member in the section having the fastening tapes to 50 mm inward in accordance with JIS K7171". Such limitations are nowhere taught or otherwise disclosed in the cited art of record, and no motivation is found in the cited art to arrive at the same.

Finally, as to the all of the cited art of the US PTO, which is being relied upon to reject pending claims, there is a possibility of the urine leakage when the direction of a diaper is reversed and the diaper is put on a wearer. Such a possibility of leakage is not associated with the instant inventive diapers, due to the particular combination of limitations that are recited in the pending claims (e.g., see claim 1).

### **CONCLUSION**

Based on the Amendments and remarks set forth herein, the US PTO is respectfully requested to issue a Notice of Allowance indicating that each of instantly pending claims 1-5 and 7 are allowed and patentable under the provisions of title 35 of the United States Code.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.



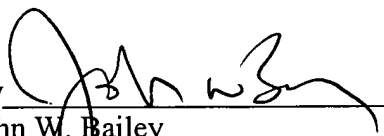
*Application No. 10/626,559*  
*Reply to Office Action of August 25, 2005*

*Docket No.: 0445-0339P*

Should the Examiner have any questions concerning the instant reply, the Examiner is respectfully requested to contact the undersigned at the telephone number provided, in order to help expedite further prosecution of this case to allowance.

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Respectfully submitted,

By 

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